

RECEIVED
CENTRAL FAX CENTER

APR 10 2006

PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400ATTORNEY DOCKET NO. 10015361-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICEInventor(s): **Will G. FETHEROLF**

Confirmation No.:

Application No.: **10/086,908**Examiner: **Liang, Leonard S.**Filing Date: **02/28/2002**Group Art Unit: **2853**Title: **VERTICAL MOUNT PRINTING DEVICE**Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on July 20, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1500☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.26. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit:

OR

☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300.Date of facsimile: **04/10/2006**

Typed Name:

Signature: Todd A. Rathe

Respectfully submitted,

Will G. FETHEROLF

By Todd A. Rathe

Todd A. Rathe

Attorney/Agent for Applicant(s)

Reg No.: **38,276**Date: **04/10/2006**Telephone: **(262) 478-8353**

Atty. Dkt. No. 10015361-1

RECEIVED
CENTRAL FAX CENTER
APR 10 2006IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Will G. FETHEROLF	CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below. <i>Todd A. Rathe</i> (Printed Name) <i>Todd A. Rathe</i> (Signature) 04/10/2006 (Date of Deposit)
Title:	VERTICAL MOUNT PRINTING DEVICE	
Appl. No.:	10/086,908	
Filing Date:	02/28/2002	
Examiner:	Leonard S. Liang	
Art Unit:	2853	

BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. Real Party In Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249, Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, California. The general or managing partner of HPDC is HPQ Holdings, LLC.

04/11/2006 EAYALEW1 00000033 082025 10086908

01 FC:1402 500.00 DA

Atty. Dkt. No. 10015361-1

2. Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellant or Appellant's patent representative.

3. Status of Claims

The present appeal is directed to Claims 29, 31, 32, 34-40, 44-48, 50-52, 54, 55 and 58-61, i.e., all of the presently pending claims that stand rejected in this application. Claims 41-43, 49, 53, 62 and 63 have been objected to while Claims 64-71 have been allowed.

4. Status of Amendments

Claims 1-21 were originally pending in the application. In response to a first substantive Office Action mailed on January 21, 2003, Appellant cancelled Claims 2, 3 and 19-21; amended Claims 1 and 14; and added Claims 22-28. In the response filed on October 27, 2003 with a Request for Continuing Examination, Appellant cancelled Claims 1, 4-18 and 22-28 and added Claims 29-61. In response to an Office Action mailed on January 21, 2004, Appellant amended Claims 29, 31, 32, 37, 39-41, 56 and 58-59; and added Claims 62-65. In response to a restriction requirement mailed on June 29, 2004, Appellant cancelled non-elected Claims 56-57; cancelled Claim 30; amended Claims 29, 58 and 59; and added Claims 66-71. In response to an Office Action mailed on October 20, 2004, Appellant cancelled Claim 33 and amended Claims 29, 31 and 58. This is an appeal from the Final Office Action mailed on April 22, 2005 finally rejecting Claims 29, 31, 32, 34-40, 44-48, 50-52, 54, 55 and 58-61. Claims 41-43, 49, 53, 62 and 63 have been objected to while Claims 64-71 have been allowed.

5. Summary of Claimed Subject Matter

Claims 29 and 59 are each directed to a media processing device which includes a media processing engine (2) having an external input (8) along an external face of the device and a media output (10) opposite the external input. The

Att'y. Dkt. No. 10015361-1

engine (2) is coupled to a structure (1) by a support (4) such that the media output (10) is below an uppermost extremity of the vertical surface and such that the external input (8) receives media while the media is in a vertical orientation. Similarly, Claim 59 is directed to a method for processing media in which a device is supported along a vertical surface and in which media is fed through an external input (8) along an external face of the device to an engine (2) while the media is substantially vertical.

Claim 31 depends from Claim 29 and additionally recites that the device, when vertically oriented, has a height, a width and a depth, wherein the first face and the second face each define the width and the depth of the engine (2) and wherein the depth is smaller than the height and the width. In other words, because the media input (8) and the media output (10) are provided in the first face and the second face, respectively, movement of media through the engine (2) is along a generally vertical or top-to-bottom path.

Claim 61 depends from Claim 59 and further recites the step of holding ejected media below the media output (10).

Claim 45 depends from Claim 29 and recites that the media input (8) is configured to receive media having a width of at least 8 inches.

Claim 51 depends from Claims 51, 50, 48 and 29 and recites that a receiver (6) which receives media from the media output (10) is configured to support the media in a tilted orientation directed away from of the vertical surface.

Claim 55 depends from Claim 29 and recites that the external input (10) is configured receive an individual sheet of media (12) from a stack of media (12) positioned proximate to the input (8). Claim 60 depends from Claim 59 and recites the step of positioning a stack of individual sheets of media (12) proximate to the media input (8).

Att'y. Dkt. No. 10015361-1

Claimed 58 recites a media processing device for use with a vertical surface. The device includes a media processing engine (2) having a media input (8) and a media output (10). The media input (8) extends along a first external face of the device and is configured such that a portion of a medium extends outwardly beyond the input (8) as the medium is being mechanically fed towards the engine. The media output (10) extends along a second external face of the device opposite the first external face, wherein the media input is configured to receive media while the media is in a vertical orientation. The device further includes means (4) for supporting the device relative to the vertical surface such that the media output (10) is below an uppermost extremity of the vertical surface.

6. Concise Statement Listing Each Ground of Rejection for Review

The issues on appeal are whether the Examiner erred in rejecting Claims 29, 31-32, 34-40, 44, 54, 58-59 and 61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al), whether the Examiner erred in rejecting Claims 45-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 5,397,192 (Khormaei), whether the Examiner erred in rejecting Claim 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 5,929,894 (Kikuchi) and whether the Examiner erred in rejecting Claims 48, 50-52, 55 and 60 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 6,290,349 (Silverbrook '349).

Atty. Dkt. No. 10015361-1

7. Argument

I. Legal Standards

Claims 21, 32, 34-40, 44-48, 50-52, 54, 55 and 58-61 have been rejected under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Plasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the "factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001). Further, it "must be based on objective evidence of record." In re Lee, 277 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed.

Atty. Dkt. No. 10015361-1

Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)). Teaching away from the claimed invention is a strong indication of non-obviousness and an improper combination of references. U.S. v. Adams, 383 U.S. 39 (1966).

Atty. Dkt. No. 10015361-1

II. The Examiner's Rejection of Claims 29, 31-32, 34-40, 44, 54, 58-59 and 61 Under 35 U.S.C. § 103(a) as Being Unpatentable Over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) Should Be Reversed Because Neither Silverbrook et al. nor Miyamoto et al, Alone or in Combination, Disclose Every Limitation of Each of the Claims.

The claimed invention is not obvious under 35 U.S.C. § 103 unless the prior art reference or references teaches or suggests all of the claim limitations. In re Royka, 490 Fed. 2d 981 (CCPA 1994). Accordingly, the rejection of these claims under 35 U.S.C. § 103(a) is improper and should be reversed.

A. Claims 29, 58 and 59.

Independent Claims 29 and 58 each recite a media processing device which includes a media processing engine having a media input along an external face of the device and a media output opposite the external input, wherein the engine is coupled to a structure by a support such that the media output is below an uppermost extremity of the vertical surface and such the media input receives media while the media is in a vertical orientation. Similarly, independent Claim 59 recites a method for processing media in which a device is supported along a vertical surface and in which media is fed through a media input along an external face of the device to an engine while the media is substantially vertical.

Neither Silverbrook '430 nor Miyamota, alone or in combination, disclose or suggest a media processing device or a method for processing media wherein the device is supported along a vertical surface, where media is fed through a media input along an external face of the device to an engine while the media is substantially vertical and is discharged from an external media output opposite the media input. The Examiner acknowledges that Silverbrook '430 fails to disclose a support coupled to the engine and configured to couple the engine to the structure such that the media output is below the uppermost extremity of a vertical surface. (Office Action dated April 22, 2005, pp. 4-5 – discussing Claim 29 and p. 5 –

Att'y. Dkt. No. 10015361-1

discussing Claims 58 and 59.) As a result, in its rejection of Claims 29, 58 and 59, the Examiner attempts to additionally rely upon Miyamota. The Examiner asserts that Miyamota discloses a support configured to couple an engine to a vertical structure. The Examiner further asserts that it would be obvious to incorporate the teaching of Miyamota into the invention of Silverbrook '430 "to gain the benefit of providing a vertical supporting means for the media processing device, so that it does not have to be held in the hand all the time." (Office Action dated April 22, 2005, p. 6.)

However, in contrast to the assertion made by the Examiner, it would not be obvious to one of ordinary skill in the art to modify the mobile phone of Silverbrook '430 to additionally include the support disclosed by Miyamota since such a modification would destroy the intended function of the mobile phone of Miyamota or of the phone of Silverbrook '430 or would require a complete redesign of the support disclosed by Miyamota. It is a well known law that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (See MPEP 2143.01 THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.)

In the present case, one of the intended purposes of the mobile phone of Silverbrook '430 is to provide an integral internal printer. In particular, Silverbrook '430 discloses a printer phone 1 in which print media 30 is fed through an entry slot 31 located on a side of printer phone 1. Miyamota discloses a portable telephone holder 1 which requires a pair of spaced belts 3 to retain the portable telephone 4 on holder 1. To modify printer phone 1 of Silverbrook '430 to additionally include telephone holder 1 would render printer phone 1 unsatisfactory for its intended purpose, printing. In particular, belts 3 of Miyamota would necessarily extend across slot 31 and interfere with or obstruct inputting of media into slot 31. Miyamota specifically discloses belts 3 as extending across a central portion of phone 1 across its keypad. To similarly position belts 3 across the keypad of Silverbrook '430 would result in belts 3 extending across and obstructing inputs slot 31 of Silverbrook '430.

Atty. Dkt. No. 10015361-1

Moreover, no teaching or suggestion exists for alternately modifying the location of belts 3 of Miyamota or omitting belts 3. Belts 3 of Miyamota are presumably located at their disclosed locations so as to not interfere with the display of the cell phone and so as to accommodate different cell phones having different lengths. To reposition the uppermost belt 3 would result in the belt 3 obstructing the display of the cell phone or may result in holder 1 not being able to accommodate differently sized cell phones. Moreover, as clear from drawing 3 of Miyamota, such belts are required to retain the cell phone in place and to prevent the cell phone from falling off of legs 19. Thus, it would not be obvious to additionally modify the location of belts 3 or to omit belts 3. Thus, the hypothetical combination of Silverbrook '430 and Miyamota as proposed by the Examiner would either render unsatisfactory the intended purpose of Silverbrook '430, printing, or would render unsatisfactory the intended purpose of Miyamota, securely retaining and supporting a cell phone. Accordingly, the rejection of Claims 29, 58 and 59 based upon the hypothetical combination of Silverbrook '430 and Miyamota would appear to be based solely upon impermissible hindsight reasoning. Appellant respectfully requests that the rejection of independent Claims 29, 58 and 59 be reversed.

B. Claim 31.

Claim 31 depends from Claim 29 and further recites that the device, when vertically oriented, has a height, a width and depth, wherein the first face and the second face each define the width and the depth of the engine and wherein the depth is smaller than the height and the width. In other words, because the media input and the media output are provided in the first face and the second face, respectively, Claim 31 is directed to the device of Claim 29 wherein movement of media through the engine is along a generally vertical or top-to-bottom path.

Neither Silverbrook '430 nor Miyamota, alone or in combination, disclose or suggest a media processing device, wherein the device, when vertically oriented, has a height, a width and a depth, wherein the first face, along which the media input extends, and the second face, along which the media output extends, each define the width and the depth of the engine. Neither Silverbrook '430 nor Miyamota

Atty. Dkt. No. 10015361-1

disclose a media processing device in which the media input and the media output are located along external faces such that media moves along a substantially vertical or top to bottom path. In contrast, Miyamota fails to disclose any media input or media output. Silverbrook '430 merely discloses an entry slot 31 which facilitates side-to-side feeding of media, not vertical or top-to-bottom feeding of media.

The Examiner apparently acknowledges this deficiency of Silverbrook '430. In particular, in his rejection of the claims, the Examiner states:

NOTE: For purposes of this rejection figure 1 of Silverbrook, et al. will be viewed in an orientation 90° to the orientation shown in the figure. The reoriented figure 1 is shown below.

(Office Action dated April 22, 2005, p. 2.)

The Examiner fails to provide any support, motivation or suggestion for reorienting printer phone 1 of Silverbrook '430 other than the teachings found in Appellant's own disclosure. Such hindsight in view of Appellant's own disclosure is impermissible.

Moreover, as acknowledged in the Office Action dated April 22, 2005, Silverbrook '430 still fails to disclose a support to couple the media processing engine of Silverbrook '430, to a vertical structure. Even assuming, arguendo, that it would be obvious to modify the printer phone 1 of Silverbrook, et al., to additionally include the portable telephone holder 1 of Miyamota, the hypothetical combination would result in printer phone 1 of Silverbrook '430 being supported in the same orientation as shown in figure 1 of Silverbrook '430 and also in the same orientation as shown in drawing 1 of Miyamota. In the orientation shown in figure 1 of both Silverbrook '430 and Miyamota, the first face along which the media input extends and the second face along which the media output extends would not define the width and depth of the engine. In the orientation illustrated in Figure 1 of both Silverbrook '430 and Miyamota, media would have to be fed through the cell phone along a horizontal or side-to-side path rather than a vertical top-to-bottom path.

Atty. Dkt. No. 10015361-1

Neither Silverbrook '430 nor Miyamota provide any motivation or suggestion for alternatively connecting portable telephone holder 1 of Miyamota to printer phone 1 of Silverbrook '430 in an alternative orientation other than that shown in drawing 1 of Miyamota. Neither Silverbrook '430 nor Miyamota provide any motivation or suggestion for reconfiguring portable telephone holder 1 to alternatively support a cell phone in a sideways horizontal orientation. In fact, one of ordinary skill in the art would seemingly be led away from such a modification in that both the screen or display of the cell phone and the keypad of the cell phone would also need to be retained in sideways orientation, making the reading of text on the display or the reading and entry of data through the keyboard of the cell phone difficult. Because the Examiner has failed to cite any motivation or suggestion for (1) reorienting printer phone 1 of Silverbrook '430 90° or (2) somehow reconfiguring the telephone holder of 1 of Miyamota to also support the printer phone 1 of Silverbrook '430 in the reoriented position, the rejection of Claim 31 based upon Silverbrook '430 and Miyamota appears to be improper as using Appellant's own disclosure as a blueprint for such a modification. Accordingly, Appellant respectfully requests that the rejection of Claim 31 be reversed for this additional reason.

C. Claim 61.

Claim 61 depends from Claim 59 and recites a further step of holding ejected media below the media output.

Neither Silverbrook '430 nor Miyamoto disclose or suggest the step of holding ejected media below the media output. Even assuming, arguendo, it would be obvious to modify the printer phone 1 of Silverbrook '430 to somehow include the telephone holder 1 of Miyamoto, the hypothetical combination would still fail to disclose any structure for facilitating the step of holding the ejected media below the media output. Even assuming, arguendo, that there was a suggestion to add a media holder to the hypothetical combination of Silverbrook '430 and Miyamoto, such a holder would not hold ejected media below the media output since media is discharged sideways from the printer phone 1 of Silverbrook '430. Accordingly,

Atty. Dkt. No. 10015381-1

Appellant requests that the rejection of Claim 61 be reversed for this additional reason.

III. The Examiner's Rejection of Claims 45-46 Under 35 U.S.C. § 103(a) as Being Unpatentable Over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 5,397,192 (Khormae) Should be Reversed Because Neither Silverbrook '430, Miyamoto et al, Nor Katsuyama, Alone or in Combination, Disclose Every Limitation of Each of the Claims.

Claim 45 depends from Claim 29 and recites that the media input is configured to receive media having a width of at least 8 inches.

The Examiner acknowledges that Silverbrook '430 fails to disclose a media input configured to receive media having a width of at least 8 inches. As a result, the Examiner attempts to additionally rely upon Khormae which indicates a common recording media may include standard 8.5 x 11 inch paper. However, the Examiner has failed to cite any motivation or suggestion for modifying entry slot 31 of the printer phone 1 of Silverbrook '430 to have a width of at least 8 inches. One of ordinary skill in the art would not be led to reconfigure printer phone 1 of Silverbrook '430 such that its entry slot 31 has a dimension of at least 8 inches. The title itself of Silverbrook '430 recites that the phone is to "hand held" and "mobile". Enlarging printer phone 1 of Silverbrook '430 such that entry slot 31 has a dimension of at least 8 inches would destroy the intended function of printer phone as being a handheld mobile phone. Practicality would dictate one of ordinary skill in the art against such a hypothetical modification of Silverbrook '430. Accordingly, Appellant respectfully requests that the rejection of Claim 45 based upon Silverbrook '430, Miyamoto and Khormae be reversed. Claim 46 depends from Claim. Thus, Appellant respectfully requests that the rejection of Claim 46 also be reversed.

IV. The Examiner's Rejection of Claim 47 Under 35 U.S.C. § 103(a) as Being Unpatentable Over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view

Atty. Dkt. No. 10015361-1

of U.S. Patent No. 5,929,894 (Kikuchi) Should be Reversed Because Neither Silverbrook '430, Miyamoto et al, Nor Kikuchi, Alone or in Combination, Disclose Every Limitation of Each of the Claims.

Claim 47 depends from Claim 29 and overcomes the rejection for the same reasons discussed above with respect to claim 29.

V. The Examiner's Rejection of Claims 48, 50-52, 55 and 60 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 6,290,349 (Silverbrook '349) Should be Reversed Because Neither Silverbrook '430, Miyamoto et al, Nor Silverbrook '349, Alone or in Combination, Disclose Every Limitation of Each of the Claims.

A. Claim 51

Claim 51 depends from Claim 50 and recites a receiver which receives media from the media output as configured to support the media in a tilted orientation directed away from the vertical surface.

Neither Silverbrook '430, Miyamoto nor Silverbrook '349, alone or in combination, disclose or suggest the media processing device having a support configured to couple a media processing engine of the device to a vertical surface and a receiver which supports media in a tilted orientation directed away from the vertical surface. The Examiner acknowledges that Silverbrook '430 fails to disclose a receiver configured to support media in a tilted orientation away from the vertical surface. (Office Action dated April 22, 2005, p. 9 discussing Claim 51.) As a result, the Examiner attempts to additionally rely upon Silverbrook '349 which discloses tray 619.

However, Silverbrook '430 discloses a handheld mobile phone with integral internal printer in which media is discharged along its side. Tray 619 of Silverbrook '349 is configured to receive media discharged from the bottom of a printer. The

Atty. Dkt. No. 10015381-1

Examiner has failed to cite any teaching or suggestion in either Silverbrook '430 or Silverbrook '349 as to how tray 619 would somehow be mounted to printer phone of Silverbrook '430. Moreover the Examiner has failed to cite any motivation or suggestion for even further reconfiguring tray 619 so as to support media in a tilted orientation away from a vertical surface. Thus, Appellant respectfully requests that the rejection of Claim 51 be reversed for this additional reason. Claim 52 depends from Claim 51 and is believed to be patentably distinct over Silverbrook '430, Miyamoto and Silverbrook '349 for the same reasons.

B. Claims 55 and 60.

Claim 55 depends from Claim 29 and recites that the media input is configured to receive an individual sheet of media from a stack of media positioned proximate to the input. Claim 60 depends from Claim 59 and includes positioning a stack of individual sheets of media proximate to media input.

As acknowledged by the Examiner, neither Silverbrook '430 nor Miyamoto disclose a media input configured to receive an individual sheet of media from a stack of media positioned proximate to the input. As a result, the Examiner attempts to additionally rely upon Silverbrook '349 and asserts that Silverbrook '349 discloses a media input configured to receive an individual sheet of media from a stack of media positioned proximate to the input. (Office Action dated April 22, 2005, p. 10 – discussing Claim 55.)

However, media tray 607 disclosed by Silverbrook '349 is internally located within printer 601. Nowhere does Silverbrook '349 or Silverbrook '430 provide any teaching, suggestion or even motivation for somehow modifying the handheld mobile phone of Silverbrook '430 to include an internal print tray such as tray 607 of Silverbrook '349. Moreover, to somehow add an internal print tray 607 as disclosed by Silverbrook '349 would seemingly destroy the intended purpose of Silverbrook '430 to provide a handheld mobile phone. In addition, since the mobile phone of Silverbrook '430 feeds media in a horizontal side-to-side fashion, it would not be possible to add an internal printer tray such as printer tray 607 of Silverbrook '349

Atty. Dkt. No. 10015361-1

without requiring a complete reconstruction of the mobile phone of Silverbrook '430. In rejecting Claim 55, the Examiner appears to be selectively picking and choosing features from different patents and hodgepodging such features together to read on the device recited in Claim 55. This piecemeal hodgepodge of parts appears to be using Appellant's own disclosure as a blueprint. Thus, Appellant respectfully requests that the rejection of Claims 55 and 60 be reversed.

Conclusion

In view of the foregoing, the Appellant submits that Claims 29, 31-32, 34-40, 44, 54, 58-59 and 61 are not properly rejected under 35 U.S.C. § 103(a) as being as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and are therefore patentable. Claims 45-46 are not properly rejected the under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 5,397,192 (Khormaei). Claim 47 is not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 5,929,894 (Kikuchi). Claims 48, 50-52, 55 and 60 are not properly rejected in under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,430 (Silverbrook '430) in view of Japanese Patent No. JP Pat 2000-184911 (Miyamoto et al) and further in view of U.S. Patent No. 6,290,349 (Silverbrook '349) and are therefore patentable. Accordingly, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

Atty. Dkt. No. 10015361-1

Summary

For the foregoing, it is submitted that the Examiner's rejections are erroneous, and reversal of the rejections is respectfully requested.

Dated this 10th day of April, 2006.

Respectfully submitted,

By Todd A. Rathe

Todd A. Rathe
Registration No. 38,276

P.O. Address:

RATHE PATENT & IP LAW
10611 W. Hawthorne Farms Lane
Mequon, WI 53097
Telephone: (262) 478-9353

Attly. Dkt. No. 10015361-1

CLAIMS APPENDIX

1-28 Cancelled.

29. (Previously Presented) A media processing device for use with a structure having a first vertical surface with an upper most extremity, the device comprising:

a media processing engine having an outer housing with a media input along a first external face of the housing and configured such that a portion of a medium extends outwardly beyond the input as the medium is being mechanically fed towards the engine and an output along a second external face of the housing, wherein the first face and the second face are opposite one another; and

a support coupled to the engine and configured to couple the engine to the structure such that the media output is below the uppermost extremity of the first vertical surface, wherein the media input is configured to receive media while the media is in a vertical orientation.

30. (Cancelled)

31. (Previously Presented) The device of claim 29 wherein the device, when vertically oriented, has a height, a width and a depth, wherein the first face and the second face each define the width and the depth of the engine and wherein the depth is smaller than the height and the width.

32. (Previously Presented) The device of claim 29 wherein the device has a straight-through media path.

33. (Cancelled)

34. (Previously Presented) The device of claim 29 wherein the media output is configured to discharge media while the media is in a vertical orientation.

35. (Previously Presented) The device of claim 29 wherein the media output is configured to discharge media while the media is in a vertical orientation.

Atty. Dkt. No. 10015361-1

36. (Previously Presented) The device of claim 29 wherein the support is configured to couple the engine to the structure such that the media input is below the uppermost extremity of the first vertical surface.

37. (Previously Presented) The device of claim 29 wherein the structure has a top along the uppermost extremity of the vertical surface and wherein the support is configured to extends opposite the top.

38. (Previously Presented) The device of claim 37 wherein the support extends opposite the first vertical surface.

39. (Previously Presented) The device of claim 38 wherein the structure has a second vertical surface opposite the first vertical surface, wherein the top extends between the first vertical surface and the second vertical surface and wherein the support is configured to wraps around the structure to extend opposite the second vertical surface.

40. (Previously Presented) The device of claim 37 wherein the structure has a second vertical surface opposite the first vertical surface, wherein the top extends between the first vertical surface and the second vertical surface and wherein the support is configured to extends opposite the second vertical surface.

41. (Previously Presented) The device of claim 29 wherein the support is movable between a first position in which the support is configured to couples the engine to the structure along the first vertical surface by wrapping around a top of the structure and a second position in which the support rests upon a horizontal surface while inclining at least a portion of the engine above the horizontal surface.

42. (Previously Presented) The device of claim 29 wherein the support is moveable between a first position in which a majority of the support extends beyond the media input and a second position in which the majority of the support extends between the media input and the media output.

Atty. Dkt. No. 10015361-1

43. (Previously Presented) The device of claim 42 wherein the support pivots between the first position and the second position.

44. (Previously Presented) The device of claim 29 wherein the media input comprises an external slot configured to enable individual sheets of media to be manually fed into the slot.

45. (Previously Presented) The device of claim 29 wherein the media input is configured to receive media having a width of at least 8 inches.

46. (Previously Presented) The device of claim 45 wherein the engine, when vertically oriented, has a height, width, and depth and wherein the depth is smaller than the height and width.

47. (Previously Presented) The device of claim 29 wherein the engine includes a photoconductive drum.

48. (Previously Presented) The device of claim 29 including a media receiver proximate the media output.

49. (Previously Presented) The device of claim 48 wherein the media receiver pivots between a first position in which the receiver hangs below the media output and a second position in which the receiver is adapted to rest upon a horizontal surface.

50. (Previously Presented) The device of claim 48 wherein the receiver receives media from the media output while the media is in a substantially vertical orientation and holds the media in a substantially vertical orientation.

51. (Previously Presented) The device of claim 50 wherein the receiver is configured to support the media in a tilted orientation directed away from the vertical surface.

Att'y. Dkt. No. 10015361-1

52. (Previously Presented) The device of claim 51 wherein the receiver is configured to support the media such that at least a portion of the media extends beyond a front of the print engine opposite the vertical surface.

53. (Previously Presented) The device of claim 29 wherein the support is pivotably coupled to the engine.

54. (Previously Presented) The device of claim 29 wherein the media processing engine is configured to print upon the media.

55. (Previously Presented) The device of claim 29 wherein the media input is configured to receive an individual sheet of media from a stack of media positioned proximate the input.

56. (Cancelled)

57. (Cancelled)

58. (Previously Presented) A media processing device for use with a vertical surface, the device comprising:

a media processing engine having a media input along a first external face of the device and configured such that a portion of a medium extends outwardly beyond the input as the medium is being mechanically fed towards the engine and an output along a second external face of the device opposite the first external face, wherein the media input is configured to receive media while the media is in a vertical orientation; and

means for supporting the device relative to the vertical surface such that the media output is below an uppermost extremity of the vertical surface.

59. (Previously Presented) A method for processing media comprising:
supporting a device having a media processing engine along a vertical surface;

mechanically feeding media through a media input along an external face of the device to the engine while the media is substantially vertical;

Atty. Dkt. No. 10015361-1

printing upon the media; and
discharging the printed upon media out an external media output
opposite the external media input from the engine while the media is in the
substantially vertical orientation.

60. (Previously Presented) The method of claim 59 including positioning a
stack of individual sheets of media proximate to the media input.

61. (Previously Presented) The method of claim 59 including holding the
ejected media below the media output.

62. (Previously Presented) The device of claim 48, wherein the media
receiver pivots between a first position in which the receiver extends substantially
parallel to a remainder of the device and a second position in which the receiver
extends non-parallel to the remainder of the device.

63. (Previously Presented) The device of claim 62 including a media
receiver proximate the media output, wherein the media receiver includes a wall
inclined beyond a front of a remainder of the device when the device is supported
along the first vertical surface.

64. (Previously Presented) A media processing device for use with a wall
having a top edge and a horizontal surface, the device comprising:
a media processing engine;
an enclosure about the engine;
a support pivotally coupled to the enclosure, wherein the support pivots
between a first position in which the support is configured to wrap about the top edge
of the wall and a second position in which the support is configured to rest upon the
horizontal surface so as to elevate at least a portion of the enclosure above the
horizontal surface; and
a media receiver pivotally coupled to the enclosure, wherein the media
receiver pivots between a third position in which the media receiver is configured to
extend along the wall while the support is in the first position, and a fourth position in

Atty. Dkt. No. 10015361-1

which the receiver is configured to extend along the horizontal surface while the support is in the second position.

65. (Previously Presented) The device of claim 64, wherein the enclosure includes a media input along a first external face of the enclosure and a media output along a second external face of the enclosure.

66. (Previously Presented) A media processing device for use with a wall having a top edge and a horizontal surface, the device comprising:
a media processing engine;
an enclosure about the engine; and
a support pivotally coupled to the enclosure, wherein the support pivots between a first position in which the support is configured to wrap about the top edge of the wall and a second position in which the support is configured to rest upon the horizontal surface so as to elevate at least a portion of the enclosure above the horizontal surface.

67. (Previously Presented) The device of claim 66 wherein the enclosure includes a media input along a first external face of the enclosure and a media output along a second external face of the enclosure opposite the first external face.

68. (Previously Presented) A media processing device for use with a wall and a horizontal surface, the device comprising:
a media processing engine;
an enclosure about the engine; and
a media receiver pivotally coupled to the enclosure, wherein the media receiver pivots between a first position in which the media receiver is configured to extend along the wall, and a second position in which the receiver is configured to extend along the horizontal surface.

69. (Previously Presented) The device of claim 68 wherein the enclosure includes a media input along a first external face of the enclosure and a media output along a second external face of the enclosure opposite the first external face.

Att'y. Dkt. No. 10015361-1

70. (Previously Presented) A media processing device for use with a wall and a horizontal surface, the device comprising:

a media processing engine;

an enclosure about the engine;

a support pivotally coupled to the enclosure, wherein the support pivots between a first position in which the support is configured to mount along a side of the wall and a second position in which the support is configured to rest upon the horizontal surface so as to elevate at least a portion of the enclosure above the horizontal surface; and

a media receiver pivotally coupled to the enclosure, wherein the media receiver pivots between a third position in which the media receiver is configured to extend along the wall while the support is in the first position, and a fourth position in which the receiver is configured to extend along the horizontal surface while the support is in the second position.

71. (Previously Presented) The device of claim 70 wherein the enclosure includes a media input along a first external face of the enclosure and a media output along a second external face of the enclosure opposite the first external face.

Atty. Dkt. No. 10015361-1

EVIDENCE APPENDIX

There is no evidence previously submitted under 37 C.F.R. §§ 1.130, 1.131 or 1.132 or other evidence entered by the Examiner and relied upon by Appellant in this appeal. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(ix) are satisfied.

RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a Court of the Board in a proceeding identified in the Related Appeals and Interferences section. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(x) are satisfied.